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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,131	10/04/2001	James C. Tuthill	21488/04040	4066
24024	7590	03/30/2004	EXAMINER	
CALFEE HALTER & GRISWOLD, LLP 800 SUPERIOR AVENUE SUITE 1400 CLEVELAND, OH 44114			WALSH, BRIAN D	
			ART UNIT	PAPER NUMBER
			3722	
DATE MAILED: 03/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/971,131	TUTHILL, JAMES C.
	<b>Examiner</b>	<b>Art Unit</b>
	Brian D. Walsh	3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 January 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 and 12-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 2-10, 12 and 18 is/are allowed.
- 6) Claim(s) 1-6, 9, 13-16 and 19-21 is/are rejected.
- 7) Claim(s) 7, 17 and 22-24 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 October 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

1. In view of the Appeal Brief filed on 16 January 2004, PROSECUTION IS HEREBY REOPENED. As set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

After consideration of the Appeal Brief submitted by Applicant prosecution has been reopened as stated above. However, upon further scrutiny, the Examiner has determined that the following new rejections under 35 USC 102(b) and 35 USC 103(a) are appropriate. Please see "Response to Arguments" below for further explanation.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4 – 6, 13, 16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Bias (U.S. Pat. No. 5,082,409).

Regarding claims 1, 13 and 16, Bias discloses a retainer (30) comprising an integral base section (31) and a generally perpendicular peripheral section (32) maintaining a cup-shaped configuration while in place over the nut (N). The base section (31) has a central aperture (34) and the peripheral section (32) has an interior surface that includes a plurality of fingers which define one or more longitudinal windows therebetween (see figures 8A and 9). The fingers having nut-engaging surfaces on the interior surface of the peripheral section (this is shown most clearly in figure 3).

Regarding claim 2, Bias discloses the nut-engaging surfaces include two surface, formed at an angle to one another. Again, see figure 3.

Regarding claim 4, Bias discloses in figure 8a that the base is flat.

Regarding claim 5, Bias shows a reinforcing ring (generally at 33 in figure 9) around the central aperture (34).

Regarding claim 6, Bias discloses the components may be made from various materials, including plastic (col. 7, line 65 - col. 8, line 4).

Regarding claim 19, Bias discloses a threaded portion and a non-threaded portion to the fastener (this can be seen in figure 3). One face of the retainer adjacent the non-threaded portion, the other face opposite the non-threaded portion.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3, 14, 15, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bias (U.S. Pat. No. 5,082,409) in view of Duran (U.S. Pat. No. 5,967,723).

Bias discloses all of the elements as set forth in the above rejections. Regarding claims 3, 14, 15 and 20, Bias also discloses finger-like projections that engage the flat surfaces of the nut (N). These projections are intended to restrict a movement of the retainer (30) with respect to the nut (N). Regarding claim 21, Bias discloses windows between the finger-like projections that extend from the base section to an open end of the peripheral section opposite the base section and that this peripheral section includes nut-engaging surfaces. However, Bias fails to disclose the central aperture includes a D-shaped or truncated circular cross section.

Duran discloses a retainer (16) similar to the instant invention comprising a peripheral section (21) bent away from a base section (17) for engaging surfaces (26) of a nut (22). Duran further discloses a D-shaped or truncated circular cross-section to a central aperture (18) which further restricts movement of the retainer with respect to the threaded fastener (11) to which the apparatus is affixed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the retainer of Bias to include the D-shaped aperture and flat surface on the fastener as taught by Duran since Duran teaches this configuration to lock a nut to

a bolt such that the two will not become loose even during extreme vibration (col. 1, lines 33 – 45).

***Allowable Subject Matter***

4. Claims 8 – 10, 12 and 18 are allowed.
5. Claims 7, 17 and 22 – 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 7 and 22, the prior art did not disclose nor render obvious a continuous ring at the end of a finger-like peripheral section having windows between the fingers on a nut retaining device. Such a modification of Duran would not destroy the workability of the device, but since the ends of the peripheral section in Duran are not bent to a position near the retained nut no teaching in the prior art would justify such a modification. Similarly, in every embodiment of Bias, the ends of the fingers are bent away from the nut being retained and modifying the ends of the fingers (peripheral section) to have a ring would not improve the workability of the device (no motivation).

Regarding claims 17 and 24, Bias shows a peripheral section that includes elements that are bent in an inward direction toward the nut being retained, however, it is clear that the inwardly bent elements are not the ends (or flared ends), which in Bias are actually flared away from the retained nut. Although such a modification would not destroy the workability of the

device, the prior art did not disclose nor render obvious a teaching that would justify such a modification to Bias.

***Response to Arguments***

7. The Examiner has considered Applicant's remarks in the Appeal Brief and concluded that modification of Duran by Bias would destroy the workability of the device by Duran. However, further review revealed that the above noted rejections under 102(b) by Bias alone properly anticipated portions of the instant invention. Furthermore, the Examiner has determined that a modification of Bias by Duran is appropriate.

***Faxing of Responses to Office Actions (UPDATED)***

8. In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to **ALL OFFICE ACTIONS** directly into the Group at **(703) 872-9306**. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the Examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the Examiner.

**PLEASE NOTE:** the fax number in the above paragraph has changed. It is to be used for all responses, **including after-final communications**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Walsh whose telephone number is (703) 605-0638. The

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examiner can normally be reached on Monday - Friday 8:30 A.M. to 6:00 P.M., with every-other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (703) 308-2159.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

*BDW*  
BDW

March 23, 2004

*A. L. Wellington*  
A. L. WELLINGTON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700